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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,408	02/27/2004	Tetsuro Wada	103203-00010	4534

4372 7590 01/09/2007
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EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
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1731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/787,408

Applicant(s)

WADA ET AL.

Examiner

John Hoffmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/047,373.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- ☐ Notice of Informal Patent Application
- ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As indicated in MPEP 2173.05(p) II:

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

Such claims should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

Claim requires both apparatus and method steps, for example

Claim 1 is clearly directed to an apparatus – as indicated by the preamble.

Claim 1 is also directed to a method, as can be seen by the steps: that the holder is being pulled (line 10) and that the moving means is moving. Since the claim is directed to neither a process nor a machine, applicant cannot obtain a patent therefore. Also, claim 3 requires an "apparatus or" a step of extending. These are just examples, it is clear that other steps are required by the apparatus claims.

Similarly, the following 112 rejection is made:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As pointed out above, the hybrid claims are indefinite. Furthermore, claim 1 requires the step of holding with the holder – typically that is considered to be a structural limitation, it also refers to the glass member being connected to the extension optical fiber glass body (this is also typically OK) – however from lines 2-3, it appears that this glass body is not actually part of the apparatus – and thus not to be interpreted as a structural limitation. Thus it is unclear whether this is directed to a method or what.

There is no antecedent basis for “the maximum temperature portion” line 21 and “said extending...preform” line 15, and “said movement means” at the third to last line and “the extending portion” (last line),

Claim 2: there is no antecedent basis for “the upper tip” (line 4).

Claim 1, lines 21-22 seem to indicate a step of connecting the joined portion. If the portion is already joined, then it cannot be connected – they mean substantially the same thing. Alternatively, the claim is incomplete because it does not indicate what the (already) joined portion is (further) connected to.

Claim Objections

Claims 1-3 are objected to because of the following informalities: The claims lack reasonable indents.

From MPEP 608.01 Form of Claims

Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation, 37 CFR 1.75(i).

There may be plural indentations to further segregate subcombinations or related steps.

Appropriate correction is required.

Claims 2-3 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claim 1 requires that the pull glass member is attached to the preform. Claim 2 requires that the dummy member is what is attached to the extension member (which appears to be the same thing as the preform). Claim 2 is of a mutually exclusive scope: only one or the other can be attached. Claim 2 takes the scope of the claim to be completely outside that required by claim 1.

Claims 2-3 are not further treated on their merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Le Noane 4407667.

Claim interpretation.

The claimed "means" do not pass the three-pronged test to meet the standard of 35 USC 112 – 6th paragraph – because none uses the "means for" language. See MPEP 2181.

Looking to figure 3 of LeNoane – either of the members 11 is the upper holder, 12 is the lower holder, 9 is the electric furnace

Although 9 is not explicitly disclosed as being "electric" it is deemed that one would immediately infer that it encompasses electric furnaces.

From MPEP 2144.01 Implicit Disclosure:

"[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

See also, *In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir 1985).

Alternatively and/or additionally: "electric" signifies an intended use, not structure. Any structure can be electrified; even insulators can hold a static electrical charge.

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Examiner could find no definition for “electric furnace” nor even an example of such a furnace. Examiner has no way to know whether the claim is limited to resistive heater – type furnaces, or if it encompasses inductive, microwave, laser, arc or the like type heaters. It would be improper for Examiner to arbitrarily apply a definition – and thus perhaps improperly limit the claim scope. There is no art-accepted definition/meaning for “electric furnace” that Examiner is aware of. Thus it appears that the broadest reasonable definition is substantially: any furnace which can be electrified. If applicant disagrees with this definition, applicant is free to set forth what the proper definition is, along with evidence and/or rationale as to why it is the broadest reasonable definition.

The PTO gives a disputed claim term its broadest reasonable interpretation during patent prosecution. Hyatt, 211 F.3d at 1372. The “broadest reasonable interpretation” rule recognizes that “before a patent is granted the claims are readily amended as part of the examination process.” Burlington Indus. v. Quigg, 822 F.2d 1581, 1583 (Fed. Cir. 1987). Thus, a patent applicant has the opportunity and responsibility to remove any ambiguity in claim term meaning by amending the application. In re Prater, 415 F.2d 1393, 1404-05 (CCPA 1969). Additionally, the broadest reasonable interpretation rule “serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.” In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364 (Fed. Cir. 2004) (quoting In re Yamamoto, 740 F.2d 1569, 1571-72 (Fed. Cir. 1984)).

The moving means: see col. 4, lines 15-17: mobile jaws indicate moving means. As to the control means: it is inherent that there is some sort of means used to control the process – either some sort of automatic control, or manual control. Even a simple on/off switch is deemed to read on the claimed “control means”. As to the claimed functionality – it begins by “when extending said optical fiber glass preform in said electric furnace.” However, examiner sees no requirement in the claim that stipulates

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that the apparatus must be capable of extending the preform in the furnace – it would be improper for examiner to read this limitation (or any limitation) into the claim without justification. Rather, it is deemed the broadest reasonable interpretation of this limitation is substantially: “whenever the apparatus is extending said optical fiber glass preform in said electric furnace...” the control means controls the moving of the maximum temperature portion (if there is such movement) and controlling the lowering of the movement means. Since LeNoane has no extending in the electric furnace, the claim does not define over LeNoane. To rephrase Office’s point: the broadest reasonable interpretation of the claimed controlling is: if there is extending, then there is specific controlling; the claim has no limitation as to what is required if there is no extending. Since LeNoane has no extending, no controlling is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

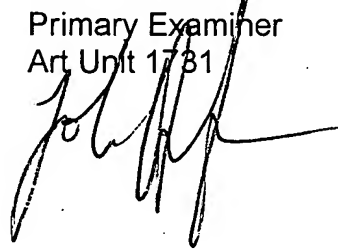
If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jmh

John Hoffmann
Primary Examiner
Art Unit 1731



1-4-06